

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 12 and 14, claims 1 to 11 and 13 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that the present application is in condition for allowance, and reconsideration is respectfully requested.

II. Allowed Claims

Applicant notes with appreciation the indication that claims 10 and 13 are allowed.

III. Allowable Subject Matter

Applicant notes with appreciation the indication that claims 3 to 5 include allowable subject matter. In this regard, the Examiner will note that each of claims 3 and 4 has been rewritten herein in independent form to include all of the limitations of its respective base claim. As such, it is respectfully submitted that claims 3 and 4 are in condition for immediate allowance. Claim 5 depends from claim 4 and is therefore also believed to be in condition for immediate allowance.

IV. Rejection of Claims 1, 2, 6 to 8, 11, 12 and 14 Under 35 U.S.C. § 103(a)

Claims 1, 2, 6 to 8, 11, 12 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,605,939 ("Jansseunne et al.") and U.S. Patent Application Publication No. 2003/00575544 ("Nathan et al."). Applicant respectfully submits that the combination of Jansseunne et al. and Nathan et al. does not render unpatentable these claims as amended herein for at least the following reasons.

As an initial matter, claim 14 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 14.

Claim 1, as presented, relates to an inductive sensor, which includes at least two circuit boards, receiver circuit traces and excitation coils both arranged on a first one of the circuit boards, and components of an evaluation electronic arrangement configured to evaluate signals that originate from the receiver circuit traces arranged on a second one of the circuit boards. Claim 1, as presented,

recites that the circuit boards are joined in a sandwich manner, the receiver circuit traces and the second circuit board in electrical contact, the excitation coils and the second circuit board in electrical contact, at least one component of the evaluation electronic arrangement arranged between the circuit boards.

Claim 11 relates to a rotary encoder that includes an analogous inductive sensor.

It is respectfully submitted that the combination of Jansseunne et al. and Nathan et al. does not disclose, or even suggest, a first circuit board having both receiver circuit traces and excitation coils arranged thereon, which is joined in a sandwich manner with a second circuit board so that the receiver circuit traces and the second circuit board are electrical contact and the excitation coils and the second circuit board are in electrical contact. Instead, Jansseunne et al. refer to only a single flexible circuit board 10, which includes a ferromagnetic layer 14 arranged thereon, and which is bent so that certain components 34 attached to the flexible circuit board 10 are electromagnetically shielded, and Nathan et al. refer to subject matter unrelated to any kind of measuring technology.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, the combination of Jansseunne et al. and Nathan et al. does not disclose, or even suggest, all of the features recited in claims 1 and 11. As such, it is respectfully submitted that the combination of Jansseunne et al. and Nathan et al. does not render unpatentable claims 1 and 11.

As for claims 2 and 6 to 8, which depend from claim 1 and therefore include all of the features of claim 1, it is respectfully submitted that the combination

of Jansseunne et al. and Nathan et al. does not render unpatentable these dependent claims for at least the same reasons more fully set forth above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 9 Under 35 U.S.C. § 103(a)

Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Jansseunne et al., Nathan et al. and U.S. Patent No. 6,969,906 ("Choi"). Applicant respectfully submits that the combination of Jansseunne et al., Nathan et al. and Choi does not render unpatentable claim 9 for at least the following reasons.

Claim 9 depends from claim 1 and therefore includes all of the features recited in claim 1. As more fully set forth above, the combination of Jansseunne et al. and Nathan et al. does not disclose, or even suggest, all of the features of claim 1. Choi is not relied upon for disclosing or suggesting the features of claim 1 not disclosed or suggested by the combination of Jansseunne et al. and Nathan et al. Indeed, it is respectfully submitted that Choi does not disclose, or even suggest, the features of claim 1 not disclosed or suggested by the combination of Jansseunne et al. and Nathan et al. As such, it is respectfully submitted that the combination of Jansseunne et al., Nathan et al. and Choi does not render unpatentable claim 9, which depends from claim 1.

In view of all of the foregoing, withdrawal of this present rejection is respectfully requested.

VI. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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